



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/693,360

10/24/2003

Shalaby W. Shalaby

SHA-46

2254

29698

7590

05/11/2007

LEIGH P. GREGORY

ATTORNEY AT LAW

PO BOX 168

CLEMSON, SC 29633-0168

EXAMINER

SILVERMAN, ERIC E

ART UNIT

PAPER NUMBER

1615

MAIL DATE

DELIVERY MODE

05/11/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/693,360

Applicant(s)

SHALABY, SHALABY W.

Examiner

Eric E. Silverman, PhD

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-12 and 15-20 is/are pending in the application.
- 4a) Of the above claim(s) 4-7,10-12,15,16 and 18-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,8,9 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

Applicants' response, filed 4/23/2007, has been received. Pursuant to amendment, claims 1, 2, 4 – 12, 15 – 20 are pending, and claims 4 – 7, 10 – 12, 15, 16, 18 – 20 are withdrawn as non-elected. Claims 1, 2, 8, 9, and 17 are discussed on the merits below.

#### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The rejection of claims 1, 2, 8 and 9 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over the claims of U.S. Patent No. 6,261,169 is **withdrawn** in view of Applicants' timely filed acceptable terminal disclaimer. The rejection of claim 3 is **moot** since that claim was cancelled.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the

Art Unit: 1615

art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The rejection of claims 13 and 14 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is **moot** since those claims were cancelled.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, 8, 9, and 17 **remain** rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for reasons of record and those discussed below.

### ***Response to Arguments***

Applicants' arguments have been fully considered, but are not persuasive. Applicants' point to the claims of several issued patents where the term "segmented copolyester" is present, and allege that this is evidence that the term is definite. However, indefiniteness is dependant on the facts of the particular case. A term which is definite in some situations may be indefinite in others. In this case, there is no definition of the term in the specification and no indication of how a "segmented copolyester" is different from a copolyester that is not segmented. As such, the artisan would not know what is included and excluded by the term "segmented copolyester", and as such would be unable to define the metes and bounds of the claimed invention.

### ***Claim Rejections - 35 USC § 102***

Art Unit: 1615

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 2 **remain** rejected under 35 U.S.C. 102(b) as being anticipated by Tian et al in *Macromolecules* for reasons of record and those discussed below.

### ***Response to Arguments***

Applicants' arguments have been fully considered, but are not persuasive. Applicants' argue that the claimed products are made by a different process than that of the prior art. However, instant claims are product-by-process claims, wherein the process only contributes to patentability when it imparts a feature or property to the product that distinguished the product over that of the art. In this case, there is no evidence of record to indicate that the product made by the method of instant claims is any different from that of the art. Specifically, Applicants' allege that the Tian copolymers would have a heat of fusion above 40 J/g. Without any evidentiary support, this statement is deemed to be mere speculation and as such cannot be a basis for patentability.

Claims 1 and 2 **remain** rejected under 35 U.S.C. 102(b) as being anticipated by Bennett et al in *Bone* for reasons of record and those discussed below.

### ***Response to Arguments***

Applicants' arguments have been fully considered, but are not persuasive. Applicants' argue that the claimed products are made by a different process than that of the prior art. However, instant claims are product-by-process claims, wherein the process only contributes to patentability when it imparts a feature or property to the product that distinguished the product over that of the art. In this case, there is no

Art Unit: 1615

evidence of record to indicate that the product made by the method of instant claims is any different from that of the art. Although Applicants' argue that such a difference exists, arguments by attorney are not substitutes for evidence of record when an evidentiary showing is required. Applicants' also argue that the instant claims are distinguished from Bennett because Bennett teaches polymers that are liquid at room temperature. However, the instant claims do not require that the polymers be non-liquid at room temperature. Indeed, the limitation of claim 1 requiring a "glass transition temperature of less than 35 C" could include polymers that have a glass transition temperature of, for example, 10 C and a melting point of, for example 15 C, which would make such polymers liquid at room temperature (room temperature being 25 C).

Claims 1 and 2 **remain** rejected under 35 U.S.C. 102(e) as being anticipated by US 7,097,907 to Bennett for reasons of record and those discussed below.

### ***Response to Arguments***

Applicants' arguments have been fully considered, but are not persuasive. Applicants' argue that the claimed products are made by a different process than that of the prior art. However, instant claims are product-by-process claims, wherein the process only contributes to patentability when it imparts a feature or property to the product that distinguished the product over that of the art. In this case, there is no evidence of record to indicate that the product made by the method of instant claims is any different from that of the art. Applicants argue that the polymers of instant claims contain a "multiplicity of chain components, which provides for improved compliance" (remarks page 9). This is not well understood, since the claims do not require a

"multiplicity of chain components". Further, Bennett teaches copolymers, which by definition have more than one (a multiplicity) monomer (component) in the polymer chain. It is also not understood what is meant by "improved compliance". Compliance with what? What is the basis of comparison for the alleged "improved" property? Absent an evidentiary showing, the alleged improvements deemed to be mere speculation, which cannot be the basis for patentability.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8, 9, and 17 **remain** rejected under 35 U.S.C. 103(a) as being unpatentable over Tian in view of US 6,309,669 to Setterstrom et al for reasons of record and those discussed below..

### ***Response to Arguments***

Applicants' arguments have been fully considered, but are not persuasive.

Applicants' first argue that the properties of the Tian polymers are not the same as those of the instantly claimed polymers. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

Art Unit: 1615

See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant then argues that "End-capping the polymer of Tian as is taught by Setterstrom, would not render obvious the present, highly compliant, segmented copolyesters". This argument fails to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Claims 8, 9, and 17 **remain** rejected under 35 U.S.C. 103(a) as being unpatentable over US 7,097,907 in view of Setterstrom et al.

### ***Response to Arguments***

Applicants' arguments have been fully considered, but are not persuasive.

Applicant argues that "End-capping the polymer of Tian as is taught by Setterstrom, would not render obvious the present, highly compliant, segmented copolyesters". However, since no reasoning is given to support this conclusion, Applicants' argument fails to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within



Art Unit: 1615


TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric E. Silverman, PhD whose telephone number is 571 272 5549. The examiner can normally be reached on Monday to Friday 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 571 272 8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Eric E. Silverman, PhD  
Art Unit 1615

  
MICHAEL P. WOODWARD  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600